

No. 14-410

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In the  
**Supreme Court of the United States**

GOOGLE INC.,

PETITIONER,

v.

ORACLE AMERICA, INC.,

RESPONDENT.

On Petition for a Writ of Certiorari  
to the United States Court of Appeals  
for the Federal Circuit

**SUPPLEMENTAL BRIEF FOR PETITIONER**

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## SUPPLEMENTAL BRIEF FOR PETITIONER

Most of the government's arguments against review would have applied equally to *Lotus Development Corp. v. Borland International, Inc.*, 516 U.S. 233 (1996). Yet this Court granted review of the same issue in *Lotus*. Since then, the circuit split has deepened and the issue has become even more important as the computer age has advanced.

The government's discussion of the merits is wrong. And it does nothing to diminish the need for this Court's resolution of the question presented.

### I. Certworthiness

1. "In no case does copyright protection for an original work of authorship extend to any . . . system [or] method of operation . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b). Notwithstanding that plain directive, the courts of appeals have divided on several related questions concerning whether original systems and methods of operation are entitled to copyright protection—as four circuits have recognized. *See* Pet. 13–14.

The government states that, while parts of the First Circuit's decision in *Lotus* "purport to rest on the proposition that Section 102(b) can foreclose copyright protection for original expression," other parts "seem to apply a principle analogous to the merger doctrine." U.S. Br. 20. In fact, the First Circuit squarely relied on Section 102(b). *See Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 815–19 (1st Cir. 1995); Reply 2–3. And it mentioned merger only in two footnotes suggesting that the merger

doctrine might exclude other elements of the work, in addition to the parts excluded by Section 102(b). *See Lotus*, 49 F.3d at 815–19 & nn.9, 13.

In any event, the government’s attempt to recharacterize *Lotus*’s holding does nothing to diminish the circuit split. The Federal Circuit rejected Google’s reliance on both Section 102(b) and merger, *see* App. 30–35, 47–49, and the petition seeks review of both holdings. The government’s contention that Google has not sought review of the merger holding (U.S. Br. 22) is baffling. The petition relies on both “Section 102(b) and, in the alternative, the merger doctrine.” Pet. 30; *see also* Pet. 19, 30–31. The question presented (in the petition, not the government’s reformulation) encompasses both doctrines by asking “[w]hether copyright protection extends to all elements of an original work . . .”—with no limitation to Section 102(b). Pet. (i); *see* Reply 10 (citing *Daimler AG v. Bauman*, 134 S. Ct. 746, 760 n.16 (2014)). The government addresses none of those points; it just asserts the opposite without explanation.

The government next argues that *Lotus* involved a computer menu hierarchy, not computer code. U.S. Br. 19–20. But the courts of appeals are divided on a legal question that does not depend on the facts of a case: whether all elements of an original and creative work are entitled to copyright protection, including systems or methods of operation. Moreover, there is no meaningful factual distinction between this case and *Lotus* because both involve the command structure for using a computer program. Reply Br. 3–4.

In any event, *Lexmark International, Inc. v. Static Control Components*, unquestionably concerns computer code. 387 F.3d 522, 529–31 (6th Cir. 2004). That decision holds, in agreement with *Lotus* but contrary to the decision below and *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222 (3d Cir. 1986), that “even if a work is in some sense ‘original’ under § 102(a), it still may not be copyrightable because [of] § 102(b).” *Lexmark*, 387 F.3d at 534; Pet. 15–16.

The government briefly recites parts of *Lexmark*, but no distinction emerges from that recital. See U.S. Br. 21. The government evidently seeks to distinguish *Lexmark* as relying on the merger and *scènes-à-faire* doctrines. But *Lexmark* squarely relied on Section 102(b). 387 F.3d at 534. Its consideration of other doctrines does nothing to diminish its Section 102(b) holding. To the contrary, it shows that *Lexmark* conflicts with the decision below on both Section 102(b) and merger.

2. Even apart from the circuit split, the question presented would warrant review due to its undisputed importance. See U.S. Br. 10, 17. The court of appeals’ decision is casting a pall over computer hardware and software development because the ability to build on existing interfaces is a critical driver of innovation and competition in high-tech fields. See Pet. 32–37; Reply 10–11.

The government argues that “the important concerns that petitioner raises . . . are better addressed through” the fair-use doctrine. U.S. Br. 22. That is a merits argument about the best way to resolve the problem; as an argument against review,

it is question-begging because it assumes the government's view of the merits is correct. Even as a merits argument, it is wrong, as explained below.

The government asserts that this case is not a suitable vehicle because “the courts below have not yet adjudicated petitioner’s fair-use defense.” U.S. Br. 22. But this Court often reviews threshold legal questions without having other possibly relevant questions before it. In *Lotus*, this Court granted review of copyrightability even though the court of appeals had not reached fair use. *See* 49 F.3d at 544. And this Court recently reviewed the analogous question of patent-eligibility in multiple cases without granting review of other related requirements for patentability and infringement. *See* Pet. 28; Reply 12.

3. The government notes that the Federal Circuit’s decision is precedential only in cases that arise within the Ninth Circuit and are appealed to the Federal Circuit. U.S. Br. 22. The government appears to present this as a vehicle issue. It is irrelevant to certworthiness because even before the decision here, certiorari was warranted in light of the pre-existing split and the issue’s importance—as confirmed by the grant in *Lotus*. *See* Pet. 19–20. Moreover, many computer software cases arise within the Ninth Circuit, and appeal will typically lie to the Federal Circuit because that court has jurisdiction over cases in which patent claims were pleaded, even if abandoned before appeal. *See* 28 U.S.C. § 1295(a)(1).

This case provides an excellent vehicle. The district court’s factual findings and the Federal



Circuit’s legal analysis crisply present the question. Pet. 29–32. And they do so in a case, concerning the widely-used Android operating system and Java programming language, that itself is exceptionally important. *See* Pet. 32–33.

The government states that “this case does not involve the copying of an ordinary computer program.” U.S. Br. 22–23. But it does not argue that any differences between these programs and ones it considers “ordinary” are relevant to the legal standard or even the outcome of this case.

The government essentially suggests that the facts are complicated. U.S. Br. 22–23. After articulating the correct legal standard, this Court could decide whether to remand or to go further by applying that standard to the facts. Pet. 32–33. Either way, this case involves only a few basic concepts of computer programming. Each Java method (pre-written program) has two parts: a header (declaration) that specifies its name, parameters, and functionality; and a body (implementing code) that instructs a computer how to perform the relevant function. Pet. 5–6. Programmers have invested time and resources into learning shorthand commands that are derived from, and correspond to, the method headers. Pet. 6–7. Programmers use those commands to cause the implementing code to perform functions, similar to how people use commands like Ctrl-P to cause a computer to print. *See* Pet. 5. If Google had not replicated the method headers precisely, the familiar shorthand commands would not work in Android. Pet. 7.

Everyone agrees that the method bodies (implementing code) may be eligible for copyright protection. The parties dispute whether the method headers are excluded from copyright protection because they are (in Oracle’s words) the “command structure” that programmers use to operate the pre-written programs. *See* Pet. 9, 30. As explained below and in the petition, they are.

## II. The Merits

The Federal Circuit held that Section 102(b) does *not* exclude “method[s] of operation” from copyright protection, and instead requires only “greater scrutiny.” App. 44. The government does not defend that vague “greater scrutiny” test, which has no basis in the statute. Pet. 21–22.

1. The government argues that Section 102(b) only codifies the idea/expression dichotomy, and thereby excludes only ideas from copyright protection. U.S. Br. 12. Ideas are, however, only one of eight exclusions: “In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, *or* discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.” 17 U.S.C. § 102(b) (emphasis added). The government would write most of those exclusions out of the statute.

The case law codified by Section 102(b), including *Baker v. Selden*, 101 U.S. 99 (1880), confirms that Section 102(b) excludes *actual* systems and methods of operation, not just the ideas underlying them. *See* Pet. 22–23; Pamela

Samuelson, *Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection*, 85 Tex. L. Rev. 1921, 1936–42 (2007). In *Baker*, Selden developed a “peculiar system of book-keeping” that employed “certain forms.” *Baker*, 101 U.S. at 99–100. This Court held that the forms—not just the idea of them—are excluded from copyright protection. *Id.* at 103, 107.

Following *Baker*, the Second Circuit (including Judge Learned Hand) found unprotected a specific “published system of shorthand,” not just the idea of using shorthand. *Brief English Sys., Inc. v. Owen*, 48 F.2d 555, 556 (2d Cir. 1931). The circuit courts likewise excluded specific charts, *Taylor Instrument Cos. v. Fawley-Brost Co.*, 139 F.2d 98, 100 (7th Cir. 1943); *Brown Instrument Co. v. Warner*, 161 F.2d 910, 911 (D.C. Cir. 1947), and methods for performing functions, *Guthrie v. Curlett*, 36 F.2d 694 (2d Cir. 1929).

As those cases reflect, systems and methods of operation have long been governed by patent, not copyright, law. *See Baker*, 101 U.S. at 102. Allowing copyright to be used as an end-run around the limits on patent protection would grant unwarranted, 95-year (or longer) monopolies on the basic building blocks of innovation—a point that *Baker* deemed significant but the government ignores. *See* Pet. 23–29.

The government underscores its error by arguing that copyright protection for a work is all-or-nothing: if a work as a whole is original and expressive, *all* of its elements are entitled to copyright protection, notwithstanding Section 102(b). U.S. Br. 13. The

government cites no authority for that startling proposition, which this Court has rejected.

“The mere fact that a work is copyrighted does not mean that every element of the work may be protected.” *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348 (1991). The requirements for copyrightability apply to all “constituent elements of a work,” not just the work as a whole. *Id.* at 363. And Section 102(b)—which limits “copyright protection for an original work,” 17 U.S.C. § 102(b)—“identifies specifically those elements of a work for which copyright protection is not available.” *Feist*, 499 U.S. at 356.

Under Section 102(b), therefore, “the copyright in [a telephone] directory” does not protect certain elements of that directory, specifically the “names, towns and telephone numbers” contained therein. *Feist*, 499 U.S. at 344. As discussed above, *Baker* likewise held that, although descriptions in Selden’s book were copyrightable, forms included in the same book were not. In keeping with those decisions, the lower courts have repeatedly distinguished an “original work’s protectable elements from its unprotectable ones”—specifically including elements of computer software. *Lexmark*, 387 F.3d at 538; see also, e.g., *Computers Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 706, 707–10 (2d Cir. 1992); *Sony Computer Ent. v. Connectix Corp.*, 203 F.3d 596, 602 (9th Cir. 2000); *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1522 (9th Cir. 1992).

The government does not acknowledge *Feist*’s rejection of its approach, much less attempt to distinguish it. With respect to *Baker*, the

government argues that this Court “decided the case based on what was effectively a merger analysis.” U.S. Br. 16. As with *Lotus* and *Lexmark*, the government’s effort to reinvent *Baker* as a merger case is wrong. *Baker* did not even reference merger. It specifically excluded systems and methods of operation from copyright protection, 101 U.S. at 100–02, 107, and Section 102(b) codifies that holding. See *Lotus*, 49 F.3d at 817. The government’s effort to take *Baker*’s holding out of Section 102(b)—even though Section 102(b) is based in part on that holding—confirms the government’s error.

2. The government’s position that Section 102(b) excludes *no* computer code is especially wrong, and especially important. See U.S. Br. 12, 14. Although other provisions of the Copyright Act single out computer programs for special treatment, *e.g.*, 17 U.S.C. § 117, Section 102(b) applies to every “original work,” without exception. 17 U.S.C. § 102(b). That is no accident: as the Copyright Office has explained, and the legislative history confirms, Congress enacted Section 102(b) “as a result of the debate over the copyrightability of computer programs,” and for the very purpose of preventing overprotection of computer software. See United States Copyright Office, *General Guide to the Copyright Act of 1976* at 3:3–3:4 (Sept. 1977); Pet. 22. As the government acknowledges, moreover, computer code is naturally described as a system or method of operation. U.S. Br. 13.

The government would nonetheless excise computer code from Section 102(b) because other provisions of the Copyright Act indicate that

computer programs “can” or “may” be copyrightable. U.S. Br. 13, 14. As explained in the petition, Section 102(b) is not so easily evaded. *See* Pet. 27. Like all original works, computer software is generally entitled to copyright protection, but Section 102(b) may exclude some or all of its elements from that protection. *See* Pet. 20–21; Reply 5–6.

The government sees no way to distinguish some computer code from other code. U.S. Br. 14–15. Any difficulty in applying a statute would provide no basis for judicially abrogating it. And although fact patterns may vary, two related guideposts should resolve most cases involving computer software, including this one.

First, if a person must learn or become fluent in something to operate a computer program, it is almost by definition part of a system or method of operating the program. *See* Pet. 30–31; *Lotus*, 49 F.3d at 817–18. That guidepost is anchored in the statutory text, which refers to a method of “operation.” It also reflects the important, common-sense principle that the creator of a system or method of operation should not be entitled to appropriate the value of investments that *others* make in learning and using it. *See Lotus*, 49 F.3d at 819–20 (Boudin, J., concurring).

Second, if lines of computer code must be copied for a program to be interoperable with another, they are part of a system or method of operating that program. *See Lexmark*, 387 F.3d at 537–38; *Sony*, 203 F.3d at 602; *Sega*, 977 F.2d at 1514. Requirements for interoperability are by definition part of a program’s system or method of operation.

This case illustrates the distinction between copyrightable and non-copyrightable computer code. As noted above, the method bodies (implementing code) may be eligible for copyright protection. But the method headers are not because they provide the “command structure” that programmers use to operate the pre-written programs, similar to how the QWERTY keyboard design is a command structure that people use to cause computers to produce letters and numbers. *See* Pet. 2–3, 31. Allowing incumbents to copyright interfaces would lock users into their existing products, imposing a very high barrier to entry for new competitors and improved products. That would block massive amounts of innovation in fast-moving, high-tech industries. Pet. 33–37.

3. The government argues that these “important” concerns “are better addressed through [a] fair use defense.” U.S. Br. 10. But Section 102(b) and fair use are fundamentally different. Pet. 28–29; CCIA Br. 27; HP Br. 18. Section 102(b) categorically excludes certain matters from copyright protection as a matter of law, and exists for the very purpose of “encourag[ing] others to build freely upon” what has come before. *Feist*, 499 U.S. at 349–50. In contrast, the fair use doctrine permits limited uses of protected material under a fact-bound, multi-factor test. Pet. 28. The Federal Circuit underscored the difference between the two by indicating that compatibility and lock-in are, in its view, not even the most important factors for a jury to consider as part of the fair-use inquiry. App. 68.

The cases cited by the government only confirm that Section 102(b) imposes a threshold, and distinct,

legal requirement. *Lexmark* noted that it need not reach fair use because it relied on copyrightability. *Lexmark*, 387 F.3d at 544. *Sony* and *Sega* held that certain elements of computer programs were excluded from copyright protection under Section 102(b) before determining whether the copying of other, protected portions was a fair use. *Sony*, 203 F.3d at 602; *Sega*, 977 F.2d at 1522.

In any event, the government's view that other doctrines can do similar work provides no basis for ignoring Congress's enactment of Section 102(b)'s threshold limit on copyright protection. This Court recently rejected essentially the same argument from the government in the context of patent eligibility—another point the government does not dispute. *See* Pet. 28 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1303–04 (2012)). After protecting competition and innovation by enforcing the limits on patent eligibility, it would make little sense to allow copyright to be used as an end-run around those limits.

\* \* \*

As the numerous *amici* explain, this Court's review is "urgently" needed to protect ongoing innovation in fast-moving industries. HP Br. 18; *see also* Pet. 36–37. The government has offered no valid reason for deferring consideration of this exceptionally important issue.



**CONCLUSION**

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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